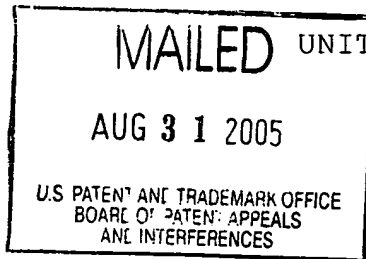


The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARK WISNIEWSKI  
and  
MELVIN S. FREEDMAN

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Appeal No. 2005-2047  
Application No. 09/408,634

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ON BRIEF

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Before KIMLIN, PAK and PAWLIKOWSKI, Administrative Patent Judges.  
KIMLIN, Administrative Patent Judge.

#### DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3-17, 20-24, 26-29, 31-33 and 35-39. Claims 1 and 24 are illustrative:

1. A closure with a directionally peelable opening feature for articles comprising a first and second layer of different polymeric films, wherein each layer has an upper and lower surface, and the lower surface of the first layer and the upper surface of the second layer each have at least one bondable area

and at least one non-bondable area, wherein the upper surface of the first layer is peelably attached to the lower surface of the second layer at a separation interface, provided that when the closure is used to secure an article, at least one non-bondable area of the lower surface of the first layer and at least one non-bondable area of the upper surface of the second layer are not attached to the article, wherein the films of the first and second layers have been uniaxially oriented.

24. A closure with a directionally peelable opening feature for articles comprising a first and second layer of different polymeric films, wherein each layer has an upper and lower surface, and at least one portion of the lower surface of the first layer and at least one portion of the upper surface of the second layer are covered by at least one bondable material, wherein the upper surface of the first layer is peelably attached to the lower surface of the second layer at a separation interface, and provided that when the closure is used to secure an article, the bondable material is attached to the article, wherein the films of the first and second layers have been uniaxially oriented.

The examiner relies upon the following references as evidence of obviousness:

Hatano et al. (Hatano)	4,915,289	Apr. 10, 1990
Freedman	4,925,714	May 15, 1990
Davis et al. (Davis)	5,637,366	Jun. 10, 1997
Greer et al. (Greer)	6,032,854	Mar. 7, 2000
		(filed Mar. 5, 1998)

Appellants' claimed invention is directed to a closure having a directionally peelable opening feature. The closure comprises first and second layers of different polymeric films that are peelably attached at a separation interface. The surfaces of the films opposite to the attached surfaces have bondable and non-bondable areas. Also, the polymeric films are

uniaxially oriented. According to appellants, "the closure creates an opening in the container beginning at the bonded edges of the first and second layers and proceeding to the non-bonded edges of the first and second layers" (page 3 of Brief, first paragraph).

Appealed claims 1, 3-14, 23, 29, 31 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Freedman in view of Hatano and Davis. Claims 15-17, 20-22, 33 and 35-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Greer in view of Freedman, Hatano and Davis. Also, claims 24 and 26-28 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Freedman in view of Davis. All the appealed claims stand rejected under 35 U.S.C. § 112, second paragraph.

Appellants submit at page 3 of the Brief that "[f]or the purposes of this Appeal, Applicants believe that the claims should stand or fall together." Accordingly, the groups of claims separately rejected by the examiner stand or fall together.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we find that the § 103 rejection of claims 1, 3-14, 23, 29, 31 and 32

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over Freedman in view of Hatano and Davis, as well as the § 103 rejection of claims 15-17, 20-22, 33 and 35-39 over Greer in view of Freedman, Hatano and Davis, are not sustainable. However, we will sustain the examiner's § 103 rejection of claims 24 and 26-28 over Freedman in view of Davis. Likewise, we will sustain the examiner's rejection of all the appealed claims under 35 U.S.C. § 112, second paragraph. Our reasoning follows.

Appellants have not addressed the examiner's rejection of all the appealed claims under 35 U.S.C. § 112, second paragraph, on the basis that "the second occurrence of 'at least one on-bondable [sic, non-bondable] are' in each of the independent claims is the same as the first occurrence" (page 2 of Final rejection, second paragraph). Accordingly, per force, we will sustain the § 112 rejection.

We will not, however, sustain the examiner's rejection of claims 1, 3-14, 23, 29, 31 and 32 under § 103 over Freedman in view of Hatano and Davis. In essence, we concur with appellants that one of ordinary skill in the art would not have been motivated to modify the labels of Freedman for mounting coupons, cards, tags or the like in accordance with the teachings of Hatano, which is directed to a sealed container. In our view, the examiner's rejection is based on what could have been

accomplished by one of ordinary skill in the art with the assistance of the impermissible hindsight gleaned from appellants' specification. It is well settled that the mere fact that the prior art could be modified would not have made the modification obvious within the meaning of § 103 unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). While the examiner states that "the structure of Freedman is a closure and structurally meets the claims of the instant invention" (page 3 of Answer, last sentence), it is only the proposed modification of Freedman that can be argued to have the claimed structure.

Concerning the § 103 rejection of claims 15-17, 20-22, 33 and 35-39 over the combination of Greer, Freedman, Hatano and Davis, we similarly find that one of ordinary skill in the art would not have had the requisite motivation to modify the sealable packages of Greer in accordance with the teachings of Freedman which are directed to peelable labels for coupons and the like. Again, the proper test for obviousness is not what could have been done by one of ordinary skill in the art but, rather, what the collective teachings of the prior art would have reasonably suggested to one of ordinary skill in the art.

We will sustain the examiner's § 103 rejection of claims 24 and 26-28 over the combined teachings of Freedman and Davis since the claims do not require at least one non-bondable area on the outer surfaces of the first and second polymeric films. As for the claim requirement that the first and second polymeric films be uniaxially oriented, we concur with the examiner that Davis evidences that the selection of uniaxially or biaxially oriented polymeric films would have been a matter of choice for one of ordinary skill in the art. We do not accept appellants' argument that Davis teaches away from using uniaxially oriented films by disclosing "that uniaxially oriented films which contain a polyester layer tend to adhere to the heated rolls of the machine direction orientation section" (page 10 of Brief, first paragraph). In fact, Davis teaches that the polymeric films are oriented either uniaxially or biaxially and, in either case, "[a] major problem in producing a structure according to this method on commercial scale equipment is the strong tendency of polyester to adhere to the heated metal rolls of the machine direction orientation section" (column 1, lines 43-46). Indeed, Davis teaches that there has been a long felt need in attaining biaxially-oriented polypropylene films that have acceptable optical and processability characteristics,

adequate interply adhesion, etc. Hence, we concur with the examiner that it would have been a matter of obvious design choice for one of ordinary skill in the art to select non-oriented, uniaxially or biaxially oriented films for the labels of Freedman. We note that appellants' specification attaches no criticality to the orientation of the polymeric films. In relevant part, the specification discloses the following:

The films may be oriented or non-oriented. When oriented, machine direction, uniaxially oriented films are preferred [page 6, last paragraph].

Accordingly, it would seem that appellants' preference for uniaxially oriented films would allay any suggestion of criticality. We further note that appellants base no argument upon objective evidence of nonobviousness, such as unexpected results.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

Edward C. Kimlin  
EDWARD C. KIMLIN  
Administrative Patent Judge

  
CHUNG K. PAK  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

  
BEVERLY PAWLIKOWSKI  
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ECK:clm



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